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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,345	03/22/2004	Richard C. Fuisz	IVMC-0003	9002

7590 02/14/2006
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EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/805,345	Applicant(s) FUISZ ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/5/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-15, 17-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15, 17-20, and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/22/2004</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|--|--|

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-10, 12-15, 17-20, and 22-28 in the reply filed on 12/5/2005 is acknowledged.

Information Disclosure Statement

The information disclosure statement filed 22 March 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The Examiner notes that in application 10/805,345 copies of the following documents were not available in the application:

- JP 7 237083 dated 09/1995
- JP 2-66482 dated 09/1990
- PTO Guidelines for Computer Related Inventions
- Amazon.com, Amazon.com Buying Information
- Johnson, Derwent-ACC_NO 199-428802
- WO0099422941A1
- Becker et al., Derwent-ACC-NO 2002-338065
- Jibiki et al., Derwent-ACC-NO 1999-428802

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- From www.findarticles.com, "The Hovering salesclerk is replaced by a computer"

The Examiner respectfully requests that copies and/or translations of these documents be provided in Applicant's response to this action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 12-15, 17-20, and 22-28 are rejected on the ground of nonstatutory double patenting over claims 1-22 of U. S. Patent No. 6,718,310 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

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common subject matter, as follows: Associating class codes with a plurality of product records, retrieving product information from a database, forwarding information to a remote user, determining whether a product is a prime motivator product, incrementing in a database a count for the purchased product, comparing class codes to determine the status of a purchased product, and the class codes representing fields of use and brands of products.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,405,175) in view of PTO 892 reference U (herein referred to as 892 U).

Regarding claim 1, Ng teaches:

means for associating a respective set of class codes with each of a plurality of product records in a database, each such product record including respective product information (see at least: col. 11, lines 9-22; Fig. 2 and 3);

means for retrieving product information for one or more products from the database (see at least: col. 11, lines 9-22; Fig. 2, 6, and 7);

means for forwarding the retrieved product information for one or more products from the database to a remotely located requestor (see at least: col. 11, lines 9-22; Fig. 2, 7, 8A-8B);

means for receiving a purchase selection from the requestor for a particular product (Fig. 1; col. 1, lines 43-46);

means for incrementing in the database a derivative count for the purchased particular product or a prime motivator count associated with the purchased particular product wherein the means for incrementing the database increments the derivative count if the purchased particular product and if not, increments the prime motivator count (see at least: col. 3, lines 29-40; col. 7, lines 15-23).

Ng teaches all of the above but does not expressly teach a *means for determining whether the purchased product is related to a prime motivator product*. 892 U teaches *means for determining whether the purchased product is related* (see at least: Page 1*).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ng to have included *means for determining whether the*

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purchased product is related as taught by 892 U in order to allow merchants to better understand response rates for online direct marketing (see at least: Page 1).*

Regarding claim 2, Ng further teaches *comparing a class code associated with the purchased particular product with a class code associated with the current prime motivator product* (see at least: col. 11, lines 9-22).

Regarding claim 3, Ng further teaches *wherein class codes of the purchased particular product and the current prime motivator product represent fields of use* (see at least: col. 7, lines 15-23; Fig. 3). The Examiner notes that the product database is searched using product information such as product type, which thereby encompasses *field of use*.

Regarding claim 4, Ng further teaches *wherein class codes of the purchased particular product and the current prime motivator product represent brands associated with these products* (see at least: col. 6, lines 31-36; Fig. 3).

Regarding claims 5-9, the limitations set forth in claims 5-9 closely parallel the limitations in claims 1-4. Claims 1-5 are thereby rejected under the same rationale.

Regarding claims 10, and 12-14, the limitations set forth in claims 10 and 12-14 closely parallel the limitations in claims 1-4. Claims 10 and 12-14 are thereby rejected under the same rationale.

2. Claims 15, 17-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,405,175) in view of PTO 892 reference U as applied to claims 1-10 and 12-14 above, and further in view of Hatanaka et al (US 2002/0161620, herein referred to as Hatanaka).

Regarding claim 15, Ng in view of 892 U teach all of the above as noted but do not expressly teach a *means for retrieving a customer history, a means for comparing the purchased particular product to subscription products identified in the customer history, and a means for determining whether the purchased particular product is related to a current prime motivator product unless the purchased product matches a subscription product in the customer history*. Hatanaka teaches a *means for retrieving a customer history, a means for comparing the purchased particular product to subscription products identified in the customer history, and a means for determining whether the purchased particular product is related to a current prime motivator product unless the purchased product matches a subscription product in the customer history* (see at least: abstract, [0021]-[0027]). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ng in view of 892

U to have included a customer history as taught by Hatanaka in order to provide organic linking between analysis results and business rules data (see at least: Hatanaka, [019]).

Regarding claim 17, Ng further teaches *comparing a class code associated with the purchased particular product with a class code associated with the current prime motivator product* (see at least: col. 11, lines 9-22).

Regarding claim 18, Ng further teaches *wherein class codes of the purchased particular product and the current prime motivator product represent fields of use* (see at least: col. 7, lines 15-23; Fig. 3). The Examiner notes that the product database is searched using product information such as product type, which thereby encompasses *field of use*.

Regarding claim 19, Ng further teaches *wherein class codes of the purchased particular product and the current prime motivator product represent brands associated with these products* (see at least: col. 6, lines 31-36; Fig. 3).

Regarding claims 20 and 22-24, the limitations set forth in claims 20 and 22-24 closely parallel the limitations of claims 15 and 17-19. Claims 20 and 22-24 are thereby rejected under the same rationale.

Regarding claims 25-28, the limitations set forth in claims 25-28 closely parallel the limitations of claims 15 and 17-19. Claims 25-28 are thereby rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 5,924,080 to Johnson discloses a computerized discount redemption system
- US 5,649,114 to Deaton et al. discloses a method and system for selective incentive point-of-sale marketing in response to customer shopping histories
- US 6,453,299 to Wendkos discloses a method for customizing queries
- US 6,266,649 to Linden et al. discloses a collaborative recommendations using item-to-item similarity mappings
- PTO 892 reference V discloses cross-selling banking services
- PTO 892 reference W discloses customer purchase tracking with up-selling

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William J. Allen
Patent Examiner
February 7, 2006